

## **Remarks**

Claims 1-10 are currently pending in this application with claims 2 and 7 amended herein. No new matter is added by these amendments.

As best understood, the arguments overcoming the rejections which preceded the filing of the Appeal Brief have been meritorious, and by their withdrawal, the present claims patentably distinguish over the combination of references cited in this matter to date.

## **Introduction**

The instant office action objects to the specification as allegedly failing to provide antecedent basis. However, since the "judging means," and "monitoring means," are expressly described in the specification at least at page 5, lines 13 -14 and lines 34-37, it is believed that this objection is in error and should be withdrawn. Further, with respect to the "means for identifying," the Examiner's attention is directed to page 5, lines 23-28 describing the functions of the notification means 53 shown in Fig. 2. Accordingly, it is submitted that all of these features are in fact supported in the specification, however, to make matters absolutely clear to the examiner the means of claims 3 and 7 have been labeled as "notifying means," to exactly recite the name of the means described in the specification. Withdrawal of the objections is requested.

## **35 U.S.C § 112 Rejection**

Next, the office action rejects claims 1-10 under 35 U.S.C. § 112, second paragraph as indefinite. Initially, it is beyond comprehension that the Examiner has allowed the instant application to proceed all the way to Appeal and beyond before rejecting the claims on these

spurious grounds. This is a clear instance of prohibited piecemeal prosecution. The Examiner's actions here have been detrimental to the applicants in that not only has unnecessary cost been accrued in this matter, but the ever increasing delay prevents the Applicants from acting on their patent rights. The Examiner is requested to keep in mind that the Applicants are entitled to expeditious prosecution of their application, something that has not occurred in this matter.

As to the instant rejection under § 112, it is submitted that the rejection is incomprehensible in its current state and that the rationale outlined for rejecting the claims is inaccurate in its interpretation of statements by the undersigned, and willfully misstates the clear statements in the specification. The following is a good faith attempt to address the rejection, however circular the rationale for rejection may be.

Initially, the office action alleges in paragraph 5a that "the specification does not clearly link and associate the corresponding structure to the judging means." (emphasis added). The Examiner's attention is directed to page 5 lines 29-37 where the specification states:

The billing server 6 comprises a communication control section 61 Which interfaces with the Internet 4, etc., on the network side and controls packet communications, and a billing database 62 which stores billing data on a user-by-user basis; the billing server 6 further comprises a judging means 62 for judging, based on the result of the monitoring from the subscriber serving apparatus 2, the billing conditions for the user to whom the service is provided.

From this paragraph, with respect to the example of the invention in Fig. 2, it is clear that the judging means 63 is a component separate from the billing database 62 or the control section 61, all of which are resident on the billing server 6. The billing server, and its components, communicate via the internet 4 with at least the monitor serving apparatus 2. Thus it is submitted that the linking of the elements of the claims can be found in the specification.

Further, with respect to the "algorithm" used by the judging means, the Examiner's attention is directed first to page 5, lines 26-27 where there is description of the notifying means 53 of the delivery server sending information to the subscriber serving apparatus specifying the data stream to be monitored. As amplified on page 6 at line 31, this information also includes a quality parameter to be reported to the billing server such as packet arrival rate. Page 7, line 14-36 goes on to clarify the interaction between the elements of the system stating:

Turning back to FIG. 3, when the subscriber serving apparatus 2 receives the monitoring information notification message (S14), its monitoring means 22 starts monitoring the specified user, the specified content data, and the specified quality parameter (packet arrival rate, etc.) based on the contents of the received information 1) to 4) described above. When the delivery of the content data is completed, the result of the monitoring is reported to the billing server 6 specified in the information 4) (S16). When the billing server 6 receives the monitoring result notification message, its judging means 63 judges whether to bill or not bill the user (S17).

In this way, according to the first embodiment, when packet missing, etc., occurs during the delivery of the content data to the user terminal 1, a monitoring result indicating the packet arrival rate lower than 100% is reported from the subscriber serving apparatus 2 to the billing server 6 which, based on the reported result, determines retroactively whether to bill or not bill the user. The user is thus assured that, if the desired delivery quality is not satisfied, the user will not be billed for the provided service.

That is, the monitoring means (element 22 of Fig. 2) of the subscriber serving apparatus 2 monitors the specified quality parameter and then reports that information to the billing server 6 whose judging means (element 63) determines, based on the result of that monitoring whether the benchmark for the quality parameter has been met. In the example above, packet arrival rate is the quality parameter and the benchmark is 100%. Depending on the settings, the judging means, in this example, can then determine whether to bill or not for the transmission of the data.

Those of ordinary skill in the art will appreciate that the judging means as described in the present application can be hardware, software, or a combination of both. Thus to meet the requirements of 35 U.S.C. § 112, second paragraph, the specification provides an example of algorithm, as described above, for making the judging determination. The algorithm, while not a strict mathematical equation as it has been presented in the specification, nonetheless meets the requirement of § 112. If the exemplary algorithm described above were to be reduced to a mathematical formula or code line it would be reduced to something such as the following:

If packet arrival rate is < 100%, then no bill.

Other quality parameters are also discussed throughout the specification, moreover, more advanced algorithms for determination of whether to bill or not are also discussed through the use of the billing judgment table 64, part of the judging means 63, described with reference to the embodiment shown in Fig. 6.

Accordingly, in view of the foregoing, it is submitted that the specification, contrary to the assertions in paragraph 6 does provide both linking of the elements of the claims to one another and also provides sufficient teachings of an "algorithm" to meet the requirements of § 112, second paragraph, with respect to both the judging means and the monitoring means.

As regards the assertions in paragraph 6 of the office action, it is submitted that the portions of the appeal brief referenced by the Examiner contain a mistake and should refer to the judging means as element 63, not element 62.

With respect to the assertions in paragraph 7, as described above the judging means 63 of the specification is provided detailed description of how the means operates and the steps it takes

to make a determination. Accordingly, use of the term judging means in the claims is not an instance of "purely functional claiming."

With respect to paragraph 8, this paragraph is now moot given the correction described above with respect to the judging means being properly considered element 63, not element 62. As to the assertion in the last sentence of this paragraph, that the judging means requires "a bill, a CPU and a data stream," this statement seeks to improperly remove one element of the claims from the context of the claim as a whole. Fig. 2, for example, clearly labels three separate servers and a user terminal. One of even minimal skill in the art would understand that each of these are computers and include a CPU. Secondly, as described in the specification each of these computers talks to the others using, for example, IP addresses, etc. Third, the bill is what is being generated by the judging means first determining the amount to bill based on the quality of the data received. Thus the assertions in paragraph 9, are clearly factually inaccurate, and in view of the clarification above, now moot.

In paragraph 9 of the office action the Examiner combines the statutory requirements of § 112, first, second, and sixth paragraphs, taking, with no clear joinder, quotes from disparate statements from the Federal Circuit. As there is nothing in the holdings of these three cases combining these three statutory requirements, the Examiner's attempt to do so is nothing short of a sloppy attempt to rewrite the statute which sets forth separate requirements, albeit with some similar indicators for compliance. Moreover, other than the statement regarding § 112, sixth paragraph, this portion of the office action is merely redundant of earlier paragraphs.

With respect to paragraph 10, it is as if the Examiner has never actually read the specification. As described in detail above, the judging means 63 and monitoring means 22 are

resident on separate servers, or computers. The monitoring means 22 is located on the subscribing server apparatus 2, and the judging means 63 is located on the billing server 6. Moreover, the specification describes the use of specified quality parameters which are set by the delivery server and which the monitoring means is notified of (page 6, lines 20-36). It is submitted that one of skill in the art, given a quality parameter of the type described in the specification would understand the technology necessary to monitor that parameter whether it be packet arrival rate, packet arrival rate within allowable fluctuation time, or some other parameter. One of skill in the art would understand that software, hardware, or a combination of both could be used to achieve this function on a server such as the subscriber serving apparatus. Accordingly, sufficient structure for monitoring means, as part of the subscriber serving apparatus has been provided, particularly, when the teachings of the types of quality parameters specified by the delivery server to be monitored, are considered.

Similarly, with respect to the judging means, as discussed in great detail above the structure of the judging means is provided in the specification. Namely it is either hardware, software, or a combination of both, resident on the billing sever, and performing the algorithms discussed above to determine whether a bill is to be presented or how much to bill.

As to paragraph 11 of the office action, an example of the algorithms used by the judging means has been described above, and further detail can be found in the specification, thus it is submitted that the requirements of § 112, sixth paragraph have been met.

Finally, with respect to paragraph 12, no new matter has been added, particularly as the specification has not been amended. Rather the specification has been read, and interpreted as one of ordinary skill in the art would given the state of the technology at the time of filing.

In view of the foregoing, it is submitted that the instant claims meet the requirements of 35 U.S.C. § 112, first, second, and sixth paragraphs, and withdrawal of the rejection is requested.

### **35 U.S.C. § 103 Rejection**

On the merits, the office action rejects claims 1-10 under 35 U.S.C. § 103(a) as unpatentable over Japanese Patent No. 200027030 to Kei in view of U.S. Published Patent Application No. 2002/0177429 to Walter.

With respect to independent claims 1 and 2 it is respectfully submitted that the relied upon portions of Walter do not teach the features alleged in the office action.

The instant invention as recited in claims 1 and 2, the billing is set based on the quality of the **delivered monitored data stream** at the subscriber serving apparatus. Walter does not teach or suggest such a system.

Rather, Walter in paragraph [0045] teaches billing based on a **selected** quality of service for the wireless device to transmit and receive packets. Based on this selection the system allocates greater network resources to serve such connections. Nonetheless, nothing in Walter actually monitors the quality data received by the device and based on this actually received quality of data bases the billing determination, as recited in claims 1 and 2.

Based on the foregoing, it is submitted that independent claims 1 and 2 patentably distinguish over the relied upon portions of Kei and Walter and are allowable. Accordingly, claims 1 and 2 patentably distinguish over the relied upon portions of the cited references and are allowable. Claims 3-10, which depend from one of these allowable base claims are allowable therewith.

### **Extraneous Arguments from the Office Action**

With respect to paragraph 16, the Examiner appears to improperly apply case law to the claims at hand. While there are indeed certain limitations in the interpretation of claims which recite "intended use," the paragraph in question bases its claim interpretation standard on the term "for." This is incorrect. The Examiner has failed to take into account the proper use of the term "for" in means-plus-function claims under 35 U.S.C. § 112, sixth paragraph. In claim limitations meeting the requirement of the statute, the language coming after the term "for" must be considered and "construed to cover the corresponding structure, material, or acts described in the specification or equivalents thereto." Failure to distinguish such an instance renders this paragraph from the office action both inoperable and incorrect. A better, though still confusing statement of the law is provided in paragraph 24. As best understood, this paragraph does indeed distinguish between § 112, sixth paragraph claims and other statements of "intended use." But it is still confusing as to why it is even included when the paragraph states "all limitations have been considered."

Further, proper claim construction is not as rigid as the Examiner attempts to render it here. While the manner and method a machine is to be utilized is not germane to the issue of patentability, here the machine in question is the "content delivery system" of the preamble and not the individual elements that make up the system. In view of the foregoing, reconsideration and restatement of exactly what principals of claim construction are being utilized by the Examiner would be greatly appreciated by the Applicants.

As regards paragraph 25, first and foremost, the specification itself provides the best statement and definition of terms used in the claims. The Examiner's statement of wholesale



application of "ordinary and accustomed meaning," are improper as it fails to reference any specific term of the claims that is being interpreted. The specification and the knowledge of one of skill in the art typically define the terms used in the instant application and unless the Examiner can point to a specific instance of claim interpretation that the Applicants might need to counter with reference to the specification, there is no need to indulge in the Examiner's recitation of various cases and their holdings, nor his methodology for interpreting the claims, nor further for the Applicant to state "the claim limitation at issue." The Applicant understands the terms he has used in both the specification and the claims and it is the Examiner's job to interpret them. There is absolutely no authority for the Examiner's request that Applicants agree to or traverse the Examiner's abstract assertions as suggested on pages 12 and 13 of the office action. The specification speaks for itself, and as it is the Examiner who in this instance must interpret the claims, that is where reference should be made to seek indication of the applicant acting as his own lexicographer. In any event, the Applicants representative duly traverses both the alleged requirement and any claim interpretation not embodied by or incorporated into the specification of the instant application.

While the law cited by the Examiner appears to be generally accepted, the Examiner's usage of such case law is not always consistent with its actual holdings. For example, in footnote 7, the "express intent," provision noted in the case law is not a requirement for the Applicants to express their intent to be their own lexicographer in the abstract, but rather it is the intent shown by actually providing a definition in the specification or in the prosecution history, typically in response to an interpretation provided by the Examiner. Again, unless the Examiner can provide some interpretation that might need to be countered, abstract statements regarding the law that the Examiner will apply is incongruous with proper patent prosecution should be

avoided. Indeed, the reasoning provided in footnote 10 as to the reasonableness of the request is circular in its logic and unfairly shifts the burden of claim construction to the Applicant when it is the Examiner's job to undertake these exercises. Such a shifting of the burden is improper not least because of its effects on prosecution history estoppel, something which applicants by their statements and actions seek to avoid in order to prevent unnecessary narrowing of their claim scope.

In short, paragraph 25 improperly seeks to shift the burden of claim construction to the applicant, invokes nonexistent requirements, and improperly applies case law of the Federal Circuit. Based on the foregoing the Applicants attorneys traverse the improper requirements, insist that the burdens of patent prosecution be properly maintained, and request that when case law is cited, it be properly used in the office action, unlike here.

With respect to paragraph 26, the first problem with this paragraph is that it comes at the end of the office action and does not state that any or all of these definitions were used interpreting and rejecting the claims of the instant application. Second, the Examiner is defining terms which are not used in the claims (see e.g., relational database), so their applicability here is suspect at best. Further, in some instances the Examiner uses ellipses such that the Applicant cannot even fully assess what it is the Examiner has asserted as the alleged definition. In other instances (e.g., Server, Client) the Examiner has chosen one of multiple definitions from the proposed dictionary to cite. This would appear to be opposite the Examiner's claim interpretation function which is supposed to employ the broadest reasonable definition possible. Thus by excluding the other possible definitions the Examiner has failed to follow his own claim construction mandates. Further, the claims limitations themselves are what must be interpreted. Thus for example, to separate the term server from either "billing server" or "delivery server," is

incorrect as each of these terms helps to refine and define, using the specification, the nature of the claim element. Accordingly, in view of these shortcomings, the Applicants do not adopt the Examiner's interpretation of these terms. While these definitions may help to define the state of the art, and/ or, may partially define terms of the instant application, they cannot be said to fully encompass the broad meaning of the claim terms as understood by one of ordinary skill in the art, the Applicant, or described in greater detail in the specification. Indeed, the Examiner's own case law citation at footnote 12 would bear out the shortcomings of the proposed definitions stating that "abstract dictionary definitions are not alone determinative." Accordingly, the definitions provided in the office action should not be found to bind or limit the interpretation of the instant claim terms.

With respect to paragraph 28, the rationale behind inclusion of this paragraph is unclear. Initially, the Examiner states that the documents referenced there are directed to those of "low skill in the art." But to the best understanding of the undersigned, low skill in the art is not a term used to quantify prior art documents. Either a document discloses something or it does not. If it does disclose something and comes earlier in time to the present application, it is prior art. The "skill level" of the document is not a consideration either by the Applicant or the USPTO. To the extent the Examiner is asserting that one of skill in the art would be aware of the teachings contained in these documents, the undersigned agrees that that is more than likely true, but as none of these references are used to reject the instant claims, the relevance of such assertion is unclear.

Paragraph 31 starts with the "presumption" that the Applicant is a skilled artisan. Likely without considering it the Examiner's entire paragraph is one of condescension and is demeaning to the Applicants. Whether the Applicant is or is not one of skill in the art is immaterial to the

prosecution of this application, and the Applicant need not wait till the Examiner deems it acceptable to request clarification of a reference cited by the Examiner. Inclusion of this paragraph at this late stage in the prosecution is doubly condescending as three times now the Examiner has alleged the claims to be unpatentable and each time the Applicants and their representative have successfully overcome the rejection, thus demonstrating at least the skill in the art evidenced by the Examiner. Again this paragraph is unnecessary to the prosecution of this application, particularly given its advanced date and only serves to increase the time and effort the Applicants spend responding to the office action.

Finally, paragraph 32 launches into a treaties like description of how the USPTO considers evidence presented to it. Moreover, this paragraph goes on to give "actual notice" of usage of knowledge of one of ordinary skill in the art. Indeed, this section of the paragraph appears to incorporate improper standards again by stating that the rejections under 35 U.S.C. § 102 incorporate this ordinary skill in the art standard. The term "ordinary skill in the art" only applies to 35 U.S.C. § 103(a) and only appears in that statute not in § 102. Thus application of that standard to § 102 is improper. Moreover, this entire paragraph on top of being legally wrong is unnecessary and only serves to prolong prosecution of this application. A proper rejection under § 103 must incorporate a statement as to why one of ordinary skill in the art would find such a combination obvious. Thus restatement of the requirements and then misstatement, in a section of the office action clearly devoid of any connection to the substantive rejection of the claims, only serves to waste the Applicants resources by requiring this response.

The Examiner is requested to refrain from taking these incredible departures from the customary practice of patent prosecution. Some 10 plus pages of the office action and six pages of this response have been dedicated to matters having little or nothing to do with the prosecution

on the merits. Such endeavors waste both the USPTO's and the Applicants resources and are not directed at providing speedy resolution of the instant application which has now been pending before the USPTO for four plus years.

### **Conclusion**

In view of the remarks set forth above, it is submitted that claims 1-10 patentably distinguish over the relied upon portions of the cited references, that the claims meet the requirements of § 112, second paragraph, and this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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